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10/730,414

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EXAMINER

KWIECINSKI, RYAN D

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/730,414	Applicant(s) TEODOROVICH, MISHKO	
	Examiner RYAN D. KWIECINSKI	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,10 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8,10 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 4, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,371,188 B1 to Baczuk et al. in view of US 6,385,925 B1 to Wark.

Claim 1:

Baczuk et al. disclose a sill pan for a window or door comprising
a sill pan base (38, Fig.2) having a length and a width, the sill pan
base comprising:

- a first end (left end, Fig.2),
- a second end (right end, Fig.2),
- a rear wall (48, Fig.2),
- a front flange (58, Fig.2),
- a lengthwise oriented rear sill support (50 towards the back,

Fig.2), and

- a lengthwise oriented front sill support (46, Fig.2),

comprising a plurality of drain gaps (58, 60, Fig.2),

- a first end piece (34, Fig.2) comprising:

an end piece base having a top surface (surface showing in Fig.2), a bottom surface (surface opposite), a first side edge (right side of 34, Fig.2), a second side edge (left edge, Fig.2), a rear edge (back wall of 34), and a front edge (58, Fig.2), such that the end piece base is attachable to the sill pan base in the proximity of the first end of the sill pan base (Fig.2)

a side upward lip (42, Fig.2) projecting from the top surface of the end piece base along the second side edge, the side upward lip extending from the front edge to the rear edge of the end piece base, and

a front lip (58, Fig.1) projecting from the top surface of the end piece base along the front edge, the downwardly extending front lip extending from the first side edge to the second side edge of the end piece base; and

a second end piece (36, Fig.2) comprising

an end piece base having a top surface, a bottom surface, a first side edge, a second side edge, a rear edge, and a front edge,

a side upward lip (44, Fig.2) projecting from the top surface of the end piece base along the second side edge, the side upward lip extending from the front edge to the rear edge of the end piece base, and

a front lip (58, Fig.2) projecting from the top surface of the end piece base along the front edge, the downwardly extending

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front lip extending from the first side edge to the second side edge of the end piece base.

Baczuk et al. do not disclose a sloped upper portion of the sill pan base nor do they disclose a downwardly extending front flange.

Wark disclose a sill pan base with a sloped upper portion as well as a downwardly extending front flange.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the sill base pan of Baczuk with a sloped upper portion in order to influence the water drained into the trough out of the drain gaps and to the exterior of the building. A sloped upper portion of a sill pan base is a well known way to cause water caught in the sill pan to exit the door frame system. It would have also been obvious to form the end pieces of Baczuk with downwardly extending front flanges in order to protect the seam between the rough frame of the door and sill pan base from water, dirt, and bugs. The downwardly extending flange will ensure the water from the trough completely exits the door framing system and does not penetrate the framed opening through the gap between the connection of the pan to the opening.

Claim 4:

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Baczuk et al. in view of Wark disclose the sill pan of claim 1,
Baczuk et al. disclose that the base is constructed of a plastic (Column 5,
lines 38-40).

Claim 8:

Baczuk et al. in view of Wark disclose the sill pan of claim 1,
Baczuk et al. also
discloses wherein the first end piece is glued (Column 9, lines 20-22) onto
the first end of the sill pan base.

Claim 10:

Baczuk et al. disclose a method of manufacturing a sill pan
comprising extruding a first sill pan base unit (Column 9, lines 1-5), the
base unit comprising

a first end (left of 38, Fig.2)

a second end (right of 38, Fig.2)

a rear wall (48, Fig.2),

a front flange (58, Fig.2),

a rear sill support (back row of 50, Fig.2), and

a front sill support (46, Fig.2)

such that the rear support and the front support on the first sill pan
base unit are lengthwise (run lengthwise of the base, Fig.2) in order to
permit the first base unit to be manufactured by extrusion;

cutting the first sill pan base unit to a desired length (Column 9,
lines 5-10);

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affixing a first end element (Column 9, lines 20-22) to the first end of the sill pan base unit; and

affixing a second end element (34, 36, Fig.2) to the second end of the sill pan base unit.

Baczuk et al. do not disclose a sloped upper portion of the sill pan base nor do they disclose a downwardly extending front flange.

Wark disclose a sill pan base with a sloped upper portion as well as a downwardly extending front flange.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the sill base pan of Baczuk with a sloped upper portion in order to influence the water drained into the trough out of the drain gaps and to the exterior of the building. A sloped upper portion of a sill pan base is a well known way to cause water caught in the sill pan to exit the door frame system. It would have also been obvious to form the end pieces of Baczuk with downwardly extending front flanges in order to protect the seam between the rough frame of the door and sill pan base from water, dirt, and bugs. The downwardly extending flange will ensure the water from the trough completely exits the door framing system and does not penetrate the framed opening through the gap between the connection of the pan to the opening.

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Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,371,188 B1 to Baczuk et al. in view of US 6,385,925 B1 to Wark in view of US 1,904,404 to Burk.

Claim 5:

Baczuk et al. in view of Wark disclose the sill pan of claim 1, they do not

disclose wherein the sill pan base is constructed of a metal.

Burk discloses wherein the sill pan base is constructed of a metal (Column 2, line 100).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed Baczuk's window sill pan from a metal material taught by Burk because metals are a known material with properties such as strength, ductility, and weather resistance that are necessary for a framing member for an opening.

Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,371,188 B1 to Baczuk et al. in view of US 6,385,925 B1 to Wark in view of US 2004/0139667 A1 to Massey et al.

Claim 6:

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Baczuk et al. in view of Wark discloses the sill pan of claim 1, but does not disclose that the first end piece snaps onto the first end of the base.

Massey et al. disclose that the first end piece snaps onto (Page 10, paragraph 135) the first end of the base.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed Baczuk's sill pan base with interlocking snap on parts as taught by Massey et al. in order to enable the pieces to be assembled and disassembled while holding a secure connection.

Claim 7:

Baczuk et al. in view of Wark in view of Massey et al. discloses the sill pan of claim 6, Massey et al. also discloses the first end piece includes at least one projecting portion (203, Fig.35); and

the first end of the base includes a slot (15, Fig.25) which accepts the projecting portion.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,371,188 B1 to Baczuk et al. in view of US 5,136,814 to Headrick.

Claim 18:

Baczuk et al. disclose a sill pan for a window or door comprising an extrudable (Column 9, lines 1-5) sill pan base (38, Fig.2) having a length and a width, the sill pan base comprising

- a first end (left side of 38),
- a second end (right side of 38),
- a rear wall (48, Fig.2),
- a rear sill support (5-, Fig.2), and
- a front sill support (46, Fig.2),

such that the rear sill support and the front sill support are oriented lengthwise on the sill pan base (runs lengthwise, Fig.2);

a first end piece (33, Fig.2), attachable to the sill pan base in the proximity of the first end of the sill pan base, the first end piece comprising

a second end piece (36, Fig.2) attachable to the sill pan base in the proximity of the second end of the sill pan base,

Baczuk et al. does not disclose a sloped upper portion nor do they disclose the structure of the end pieces.

Headrick disclose the structure of the end pieces comprising a horizontal tab (37, Fig.1) which may be inserted between the rear support and the front support, the horizontal tab having a top surface (37, Fig.1) aligned with the top surfaces of the rear support and the front support (when inserted in the frame member 12, the top surface of 37 will align with the top surfaces of the support 22 and 27),

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a recess (the indentation next to 41, Fig.1) for receiving and overlapping the first end of the rear wall,

a recess (the recess with side 43, Fig.1) for receiving the first end of the rear sill support, and

a recess (underneath 44, Fig.1, the front support is able to fit under 44) for receiving the first end of the front sill support.

The second end piece is rejected with the same explanation as the first end piece above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the sill base pan of Baczuk with a sloped upper portion in order to influence the water drained into the trough out of the drain gaps and to the exterior of the building. A sloped upper portion of a sill pan base is a well known way to cause water caught in the sill pan to exit the door frame system.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the end pieces of the sill pan base of Baczuk et al. with interlocking tabs and recesses in order to provide an attachable end piece member. Being able to interlock the end pieces to the base will shorten the assembly time of the sill pan member. Interlocking end pieces will also allow the individual pieces to be replaced if necessary due to structural damage etc. Snap fit and interlocking connections are notoriously well known connection methods and would make the sill pan more user friendly during installation.

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Claim 19:

Baczuk et al. in view of Headrick disclose the sill pan of claim 18, Headrick also discloses wherein the horizontal tab of the first end piece is tapered (37, Fig.1).

Claim 20:

Baczuk et al. in view of Headrick disclose the sill pan of claim 18, Headrick also discloses further comprising

- a front flange (21, Fig.1) projecting downwardly from the front of the extrudable sill pan base (12, Fig.1);
- a recess (the front flange is able to fit underneath 44, Fig.1) in the first end piece for receiving a first end of the front flange; and
- a recess (the front flange is able to fit underneath 44, Fig.1) in the second end piece for receiving a second end of the front flange.

Response to Arguments

The declaration under 37 CFR 1.132 filed 22 April 2008 is insufficient to overcome the rejection of claims 1, 10, and 18 based upon Baczuk et al., Wark, and Headrick under 35 U.S.C. 103 as set forth in the last Office action because:

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success.

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The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating:

In the ex parte process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sales constitute commercial success. **C.f. Ex parte Remark, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in ex parte prosecution proceedings because examiner has no available means for adducing evidence).** Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. **In re Mageli, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973)**

On page 5 of the declaration, Applicant talks about the sales and market share of the sill of the present invention, but does not provide a specific reasoning for what caused the results of the sales or the changes in the market shares. There is no evidence provided that changes in the design of the current sill were the cause of the results in the sales or the results of the changes of the

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market share. Applicant also states "I believe that Suresill currently has the largest market share for sill pans". This is simply an opinion and is not backed up by factual evidence.

Establishing long-felt need requires objective evidence that an art recognized problem existed in the art for a long period of time without solution. The relevance of long-felt need and the failure of others to the issue of obviousness depends on several factors. First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. **In re Gershon, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967).**

Second, the long-felt need must not have been satisfied by another before the invention by applicant. **Newell Companies v. Kenney Mfg. Co., 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988).**

Third, the invention must in fact satisfy the long-felt need. **In re Cavanagh, 436 F.2d 491, 168 USPQ 466 (CCPA 1971).**

The key additions to the claims that the Applicant points out in the independent claims listed in the declaration are the sloped upper portion, the lengthwise supports to allow extrusion, and the first and second end pieces. It is shown by the prior art of record that the three areas of emphasis were areas of long felt need, but the prior art also discloses that the designs of the sills/sill pans of the art of record satisfy these long felt needs.

Baczuk discloses forming the sill pan by extrusion with lengthwise support, Baczuk also discloses the first and second end pieces. Wark discloses a sill pan

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with a sloped surface to eliminate moisture from entering the opening (long felt need).

The first competitor discussed in “Jamsill” in which Applicant declares changed their design after the sill pan of the present invention was put on the market. This is simply a change in design of the competitor’s product and does not relate to the patentability of the limitations of the claims.

The Wark competitor is said to have non-continuous support along with only three reported sizes. Once again this comparison does not relate to the claims at hand, since the claims fail to provide any support of “continuous support” as well as differing sizes of the sill.

It is also stated that Burk does not disclose drain channels, but the combination of Burk was to simply provide support for forming the sill pan of a metal material and not to provide the structure of the sill pan,

Applicant also states that the patents of Baczuk, Headrick, and Massey are all sills and not sill pans. There is no differentiation in the claims between a sill pan and a sill. The inventions of the above named patents all are placed in the opening of a window or a door to prevent moisture from entering the opening.

Regarding the product recognition, the reviews and endorsements listed in the declaration do not provide insight on the claimed subject matter at hand. The statements listed do not provide any specifics to the limitations presented in the claims, they simply provide statements that the sill has been tested against others in the market.

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Applicant's arguments filed 22 April 2008 have been fully considered but they are not persuasive.

Applicant argues that Baczuk teaches injection molding and not extrusion. This is not persuasive. Applicant also argues that as stated in the declaration extrusion lowers the costs of production and allows longer lengths of sill pans to be formed for cutting. Baczuk does in fact disclose extrusion (Column 9, lines 4-5), which would allow the sill pan of Baczuk to be formed in greater lengths to be cut and lower production costs.

Applicant argues that Wark cannot be formed from extrusion due to the window support ribs. This is not found persuasive because the prior art reference of Wark is used to teach a sloped upper portion and a downwardly extending front flange, which in combination with Baczuk can in fact be extruded with the sill portion (38).

Applicant argues that there is no motivation to combine a "window drain", "a door sill assembly", and a "threshold and door sill assembly". The above listed inventions are all analogous art and all inserted into an opening of a window or a door in order to primarily protect the opening from moisture, dirt, insects, and debris. It would have been obvious to have combined the inventions above. There are no structural limitations in the claims that distinguish a "sill" from a "sill pan" if there is in fact a distinguishable difference. The term "sill" is used quite broadly in the art and usually refers to a horizontal member in the lower section of an opening in a wall.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN D. KWIECINSKI whose telephone number is (571)272-5160. The examiner can normally be reached on Monday - Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571)272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RDK

/Ryan D Kwiecinski/
Examiner, Art Unit 3635

/Robert J Canfield/

Supervisory Patent Examiner, Art Unit 3635